	Application No.	Applicant(s)			
Notice of Allowability	09/743,825 Examiner	CHAQUI ET AL.			
or mondaming	Evalitiliai	AT OILL			
	MINH-TAM DAVIS	1642			
The MAILING DATE of this communication appears on the cover sheet with the correspondence address All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS. This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.					
1. This communication is responsive to interview of 05/08/06.	1. This communication is responsive to interview of 05/08/06.				
2. The allowed claim(s) is/are <u>2-3, 5, 10, 12, 17, 19, 27-31, 33</u>	3, renumbered as 1-13.				
3. ☐ Acknowledgment is made of a claim for foreign priority unappriority and all blue blue blue blue blue blue blue bl					
 Certified copies of the priority documents have 					
2. Certified copies of the priority documents have	-				
3. Copies of the certified copies of the priority do	cuments have been received in this	national stage application from the			
International Bureau (PCT Rule 17.2(a)).					
* Certified copies not received:					
Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.					
4. A SUBSTITUTE OATH OR DECLARATION must be subm INFORMAL PATENT APPLICATION (PTO-152) which give	itted. Note the attached EXAMINER es reason(s) why the oath or declara	'S AMENDMENT or NOTICE OF tion is deficient.			
5. CORRECTED DRAWINGS (as "replacement sheets") mus	st be submitted.				
(a) ☐ including changes required by the Notice of Draftspers	on's Patent Drawing Review (PTO-	948) attached			
1) 🔲 hereto or 2) 🔲 to Paper No./Mail Date					
(b) ☐ including changes required by the attached Examiner's Paper No./Mail Date	s Amendment / Comment or in the C	Office action of			
Identifying indicia such as the application number (see 37 CFR 1 each sheet. Replacement sheet(s) should be labeled as such in t					
6. DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.					
Attacherant					
Attachment(s) 1. M Notice of References Cited (PTO-892)	5. Notice of Informal P	Patent Application (PTO-152)			
2. Notice of Draftperson's Patent Drawing Review (PTO-948)	6. 🛛 Interview Summary	(PTO-413),			
Information Disclosure Statements (PTO-1449 or PTO/SB/0 Paper No./Mail Date	Paper No./Mail Da 08), 7. ⊠ Examiner's Amendr				
4. Examiner's Comment Regarding Requirement for Deposit	8. Examiner's Stateme	ent of Reasons for Allowance			
of Biological Material	9. ☐ Other <u> </u>				
		•			

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Page 2

Art Unit: 1642

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with NANCY AXELROD on 05/08/06 and 05/16/06.

The application has been amended as follows:

In the specification;

1) The following continuation data was inserted to the first line after the title, on page 1 of the specification:

RELATED APPLICATIONS

This application is a 371 national stage Application of PCT/US99/16831, filed on 07/23/1999, which claims benefit of Application Serial Number 60/094,137, filed on 07/24/1998, now abandoned.

2) The specification was amended as follows:

In the specification, page 5, line 28th, after the first "transcript" word ---- (SEQ ID NO:1 and SEQ ID NO:2, respectively) --- was inserted.

In the specification, page 5, line 28th, after "the 5 kb transcript" --- (SEQ ID NO:3 and SEQ ID NO:4, respectively) --- was inserted.

In the claims:

Claims 1, 4, 6-9, 11, 13-16, 18, 20-26, 32, 34-40 were cancelled.

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Claim 19 was amended as follows: "from a primary prostate tumor" was deleted, and --- of a tissue from a primary prostate cancer --- was inserted.

Claim 30 was amended as follows: "from a primary prostate tumor" was deleted, and --- of a tissue from a primary prostate cancer --- was inserted.

- 2. The amendment of claims 19, 30 is supported on page 3, last paragraph, and page 13, example 1. The amendment obviates the 112, first paragraph, new matter issue for the language "a sample from a primary prostate tumor".
- 3. The request of 11/09/04 and 05/26/06 to correct inventorship, by adding Michael R. Emmert-Buck as an inventor is granted and entered (see the enclosed PTO-90).
- 4. The following is an Examiner's statement of reasons for allowance:

The claimed nucleic acid and method of detecting prostate cancer is novel. The closest prior art for SEQ ID NO:1 is the cDNA SEQ ID NO:21(HP10302) of 2373 nucleotides in length from a liver cDNA library, as taught by Kato et al (WO 98/21328-A2, p. 56-57, of record), which is only 99.5% similar to SEQ ID NO:1 of 2326 nucleotides in length of the instant application, from nucleotide 64 to nucleotide 2317 of SEQ ID NO:1 of the instant application (see the Office action of 05/05/04, on pages 19-20). Moreover, Kato et al do not teach or suggest that SEQ ID NO:21 is overexpressed in prostate cancer, nor a method for detecting prostate cancer, using SEQ ID NO:21. The closest prior for SEQ ID NO:7 is a 20 nucleotide primer, taught by Kachiku (JP08154685-A, published on 06/18/1996), which is only 58% similar to SEQ ID NO:7 (see MPSRCH search report, 2006, us-09-743825-7.rng, pages 7-8). The closest prior for SEQ ID NO: 8 is a 20 nucleotide primer, taught by Buell et al (US 6,509,163-B1), which is only 61% similar to SEQ ID NO:8 (see MPSRCH search report, 2006, us-09-743825-8.rng, page

4). The closest prior for SEQ ID NO:10 is a 20 nucleotide primer, taught by Feder et al (US 6,849,399-B1), which is only 63% similar to SEQ ID NO:10 (see MPSRCH search report, 2006, us-09-743825-10.rng, page 4).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 571-272-0830. The examiner can normally be reached on 9:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY SIEW can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MINH TAM DAVIS May 31, 2006

SUPERVISORY PATENT EXAMINER

Application/Control Number: 09/743,825

Art Unit: 1642

Page 5



UNITED STATES DEPARTMENT OF COMMERCE U.S. Patent and Trademark Office

DATE MAILED:

Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION		ATTORNEY DOCKET NO.
			EXAMINER	
				•
			ART UNIT	PAPER
				20060512

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The request of 11/09/04 and 05/26/06 to correct inventorship, by adding Michael R. Emmert-Buck as an inventor, in addition to the existing inventors Rodrigo F. Chaqui, Kristina A. Cole, and Lance A. Liotta is granted and entered. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 571-272-0830. The examiner can normally be reached on 9:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY SIEW can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MINH TAM DAVIS May 31, 2006 VENABLE...

575 7th Street, NW Washington, DC 20004-1601 Telephone 202-344-4000 Facsimile 202-344-8300

www.venable.com

TO:

Examiner Minh-Tam Davis

U.S. PTO

SENDER:

Nancy J. Axelrod

DATE: 5/16/2006

SENDER'S FAX NUMBER: 202-344-8300

SENDER'S ASSISTANT: Lili Froehling

31978-202420

PHONE NUMBER: FAX NUMBER: (571) 273-0830

SENDER'S PHONE NUMBER:

202-344-8334

ASSISTANT'S PHONE NUMBER:

PAGES, EXCLUDING COVER:

202-344-4284

CLIENT/MATTER NUMBER:

MESSAGE:

Re: S/N 09/743,825

Dear Tam,

In accordance with your telephonic request today, enclosed is another copy of the paper we filed in the above-referenced application on June 9, 2005. This paper provides copies of references that had been cited by the Examiner, and that had apparently been lost by the PTO.

With best regards,

Nancy Axelrod, Ph.D. Patent Agent VENABLE LLP 575 7th Street, N.W. Washington, DC 20004-1601 202-344-8334 direct 202-344-4000 main 202-344-8300 fax http://www.venable.com mailto:njaxelrod@venable.com

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	· ·	Attorney/LAA:	NJA/rahs
		PTO Due Date:	
		Date Filed:	June 9, 2005
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17/002		TM Official	
enable Filing Number		Gazette Date:	· · · · · · · · · · · · · · · · · · ·
Atty. Docket No:	31978-202420		·
Re:	"PB39, A GENE DYSREGULATED IN PROSTATE	CANCER, AND U	ISES THEREOF" -
	R. CHUAQUI et al	Appl'n Filing	JANUARY 15, 2002
Application No:	09/743,825	Date:	JAHOAK: 10, 2002
Patent No. :		Issue Date:	•
The follow	ing Items were received from Venable, Washington, D.C	., by the U.S. Pater	it & Trademark Office:
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Date Filed: Request for Continue	ed Examination (RCE) under 37 CFR 1.114		
Request for Reconsi	deration		Brief on Appeal Fee
Application Data She Assignment w/Cover			Oral Hearing Request Fee
IDS W/ PTO/SB/08A			T t
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RESPONSE TO	NOTICE UNDER 37 C.F.R. 1.251 UNDER 37 C.F.R. 1.251 w/ REFERENCE		Issue Fee
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Appeal Brief (in trip	licate)		Publication Fee
Reply Brief (In translation of Hea	iplicate)/ Request for Oral Hearing		Maintenance Fee
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PATENT

Attorney Docket No.: 31978-202420

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: R. Chuaqui et al.

: Examiner: Minh-Tam DAVIS

Serial No.: 09/743,825

: Group Art Unit: 1642

Filed: January 15, 2002

: USPTO Customer No.: 45323

For: PB39, A GENE DYSREGULATED IN

: Confirmation No. 8611

PROSTATE CANCER, AND USES THEREOF

RESPONSE TO NOTICE UNDER 37 C.F.R. 1.251

Assistant Commissioner of Patents P.O. Box 1450
Alexandria, VA. 22313-1450
ATTENTION: MAIL STOP AF

Sir:

In response to the Notice Under 37 C.F.R. 1.251, applicant have provided copies of the last two references from the "List of References Cited by Examiner (PTO-892), dated May 5, 2004. The copy of each paper is a complete and accurate copy of applicant's record of such paper.

Respectfully submitted,

Date: June 9, 2005

Nancy J. Axelrod, Ph.D. Registration No. 44,014

VENABLE LLP 575 7th Street, NW

Washington, D.C. 20004-1601 Direct telephone: (202) 344-8334

Telefax: (202) 344-8300

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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

NOTICE UNDER 37 CFR 1.251 - Pending Application

The file on the cover sheet cannot be located after a reasonable search. Therefore, the Office is initiating the reconstruction of the file of the above-identified application pursuant to the provisions of 37 CFR 1.251.

Applicant is hereby requested to provide a copy of applicant's record (if any) of all of the correspondence between the Office and applicant for the above-identified application (except for U.S. patent documents), a list of such correspondence, and a statement that the copy is a complete and accurate copy of applicant's record of all of the correspondence between the Office and the applicant for the above-identified application (except for U.S. patent documents), and whether applicant is aware of any correspondence between the Office and applicant for the above-identified application that is not among applicant's records.

The following paper(s) pertaining to the above-identified application cannot be located after a reasonable search:

The last two references from the "List of References Cited by Examiner (PTO-892)," dated 5/5/04:

MPSRCH sequence search report, 2004, us-09-743-825-1.mg, pages 4-6

Genbank Sequence Database, Accession No: G22380, and MPSRCH search report, 2004, us-09-743-825-7.rge, p. 1-2, and us-09-743-825-10.rge, p. 1-2

Therefore, the Office is initiating the reconstruction of such paper(s) pursuant to the provisions of 3 7 CFR 1.251.

Applicant is hereby requested to provide a copy of the paper(s) listed above and a statement that the copy of such paper(s) is a complete and accurate copy of applicant's record of such paper(s).

If applicant does not possess any record of the correspondence between the Office and the applicant for the file listed on the cover sheet or any copy of the paper(s) listed, applicant must reply to this notice by providing a statement that applicant does not possess any record of the correspondence between the Office and the applicant for the above-identified application.

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☐A printout from PALM of the contents of the file of the	he above-identified application is included with this notice.
Direct the reply to this notice to:	U. S. Patent and Trademark Office Mail Stop: Duplicates Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450
Direct questions concerning this notice to:	Image Assistance Center/ Customer Service
	1-(888)-786-0101
PTO Doc. Code: R251.NTC (Rev. 03/05)	

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Approved for use through 07/31/2006.OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

U.S. Patent and 1790cmark Critice, U.S. Date (U.S. Patent and 1790cmark Critice) (U.S. Patent and 1790cmark Critice)

In re Application of:

Application No.:

RODRIGO F. CHAQUI et al.

09/743825

Filing Date: 01/15/2002

Title: PB 39, A GENE DYSREGULATED IN PROSTATE CANCER

AND USES THEREOF

Direct to: U. S. Patent and Trademark Office

Mail Stop: Duplicates
Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

NOTICE UNDER 37 CFR 1.251 - Pending Application

Statement (check the appropriate box):

The copy submitted with this reply is a complete and accurate copy of applicant's record of all of the correspondence between the Office and the applicant for the above-identified application (except for U.S. patent documents), and applicant is not aware of any correspondence between the Office and applicant for the above-identified application that is not among applicant's records.

The copy of the paper(s) listed in the notice under 37 CFR 1.251 is/are a complete and accurate copy of applicant's record of such paper(s).

The papers produced by applicant are applicant's complete record of all of the correspondence between the Office and the applicant for the above-identified applicant (except for U.S. patent documents), and applicant is not aware of any correspondence between the Office and the applicant for the above-identified application that is not among applicant's records.

□ Applicant does not possess any record of the correspondence between the Office and the applicant for the above identified application.

June 9, 2005

Signature

Nancy J. Axelrod, Reg. No. 44,014
Typed or printed name

A Copy of this notice should be returned with the reply.

Burden Hour Statement: This collection of information is required by 37 CFR 1.251. The information is used by the public to reply to a request for copies of correspondence between the applicant and the USPTO in order to reconstruct an application file. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This form is estimated to take 60 minutes to complete. This time will very depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 223131450.

PTO Doc Code: R251.RES (Rev. 03/05)

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Thu Apr 15 09:03:59 2004

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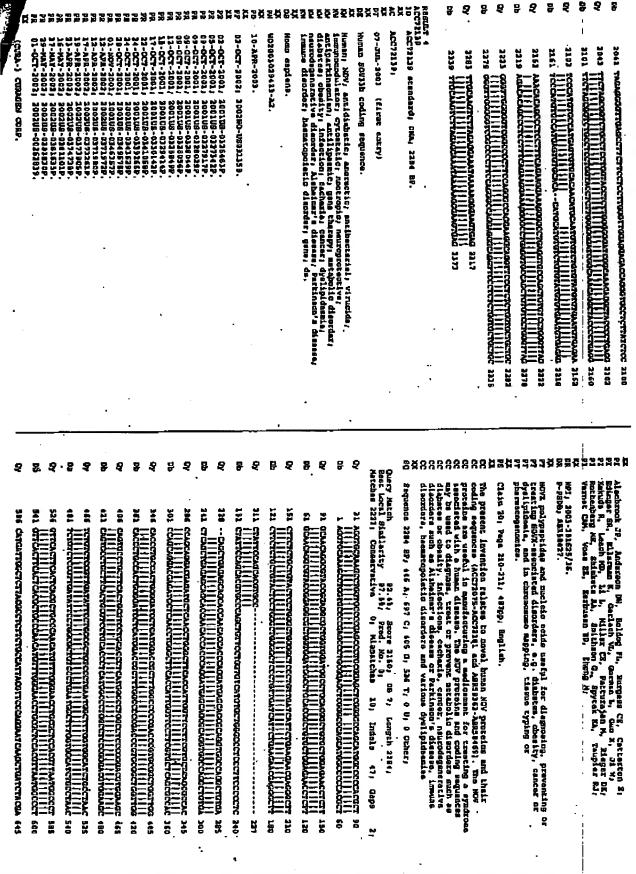
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PAGE 7/10 * RCVD AT 5/16/2006 5:32:44 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/38 * DNIS:2730830 * CSID:202 344 8300 * DURATION (mm-ss):03-44

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NCBI Sequence Viewer







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☐ 1: <u>G22380</u>. human STS WI-1700...[gi:1342706]

STS 31-MAY-1996 linear DNA 321 bp G22380 LOCUS

DEFINITION human STS WI-17004, sequence tagged site.

G22380 ACCESSION

G22380.1 GI:1342706 VERSION

STS; STS sequence; primer; sequence tagged site. **KEYWORDS**

Homo sapiens (human) SOURCE

ORGANISM Home sapiens

Eukaryota; Metazoa; Chordata; Craniata; Vertebrata; Euteleostomi;

Mammalia; Eutheria; Primates; Catarrhini; Hominidae; Homo.

1 (bases 1 to 321) REFERENCE

Hudson, T. AUTHORS

Whitehead Institute/MIT Center for Genome Research; Physically TITLE

Mapped STSs

Unpublished (1995) JOURNAL

COMMENT

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Email: thudson@genome.wi.mit.edu

Primer A: TTTATAAATCTACGGCCATGGC Primer B: CTGGATGACAGGCAATCAAG

STS size: 101

PCR Profile: Presoak:

Denaturation:

Annealing: 56 degrees C

Polymerization: PCR Cycles: 35

Thermal Cycler:

Protocol:

Template: 10 ng Primer: each 5 pM dNTPs: each 4 nM

Taq Polymerase: 0.025 units/ul

Total Vol: 20 ul

Buffer:

MqC12: 1.5 mM KC1: 50 mM Tris-HCL: 10 mM

pH: 9.3

Derived from dbEST (genbank accession R00504).

Location/Qualifiers

SOUTCE

FEATURES

1..321

301 atttcacctt tagggggcaa g

In Viewer

```
/organism="Homo sapiens"
                  /mol_type="genomic DNA"
                  /db_xref="taxon:9606"
                  /map="291.1 cR from top of Chrll linkage group"
                   35..135
  STS
                   35.,56
  primer bind
                   complement (116..135)
  primer bind
      1 throagtettt acaassatag aacttetett ggtatttata aatetacgge catggeteta
IGIN
     61 tgtgcatgtt acaggtagaa aagccatatg gggcactcct tttggttgct caggecttga
    121 tigectgica tocagggece tiggictgag aagtetatge ggteaccica gageegetaa
    181 geacetteag tgggcccate ceattggegg egtacteetg etggageegg geacggtaat
    241 agaagaggta gggaaggcaa caggaateee agggggagtga ggaatageag gaggeeecag
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